

## REMARKS

### A. 35 U.S.C. §103

#### 1. Ernst

In the Office Action mailed on May 16, 2006, claims 1, 6, 7 and 9-11 were rejected under 35 U.S.C. § 103 as being obvious in view of Ernst. Applicant traverses the rejection.

Independent claim 1 recites a position measuring system that includes a wall having an integral deformation and a cable having a shield. The Office Action has identified aperture 67 as an opening of the cover 64 that defines a deformation. The Office Action has conceded that Ernst does not disclose a deformation that is integral with cover 64. The Office Action appears to be asserting that it would have been obvious to have the bushing located between the cable cord 66 and the aperture 67 to be integral with the cover 64. The Office Action has relied on *Howard v. Detroit Stove Works* for the proposition that “it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.” The reliance on *Howard* is misplaced since *Howard* was decided over fifty years prior to the enactment of 35 U.S.C. § 103 in 1952 and so its applicability to the present case is questionable. In addition, the statement relied on by the Office Action is at best dicta, since the third patent in question was held to be anticipated and there appeared to be no issue in the discussion of the prior art that the claims recited one piece while the prior art disclosed separate pieces. Even if *Howard* is applicable to the present case, it does not contradict the fact that there must be a showing in the present rejection that it would have been obvious to one of ordinary skill in the art to alter Ernst to have its cover 64 include an integral deformation per *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). With that said, there has been no showing

in the present rejection that there is motivation in Ernst or the prior art to alter Ernst to have its cover include an integral deformation. One of ordinary skill would interpret the cable bushing shown in FIG. 6 to be an elastic material that seals the space between the cover 64 and the cable cord 66 in the opening 67. It would not have been obvious to have the cover 64 and the cable bushing integral with one another since the cover is made of an inelastic rigid material and the bushing is made of an elastic resilient material. Having the cable bushing made of an inelastic rigid material would result in the housing deforming in the area of the opening defined by the inelastic bushing due to the movement of the cable cord 66 which is of course undesirable. Without such motivation, the rejection is improper and should be withdrawn. *In re Chu*, 66 F.3d 292, 298, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

The rejection is improper for the additional reason that Ernst does not disclose that the cable cord 66 has a shield. The Office Action asserts that FIG. 6 suggests such a shield. A review of FIG. 6 does not show a shield. At most, FIG. 6 shows cable cord 66 is an ordinary cable with a covering of supposedly electrically insulating material. Since FIG. 6 fails to show a shield and the rest of Ernst does not disclose or suggest a shield for cable cord 66, claim 1 is not rendered obvious by Ernst. Accordingly the rejection should be withdrawn. Despite the impropriety of the rejection, claim 1 has been amended to clarify that the cable is a shielded cable and that the shield prevents electro-magnetic interference. Since Ernst does not use such a shield for cable cord 66, the rejection should be withdrawn.

The rejection is improper for the additional reason that Ernst does not disclose or suggest having a deformation that binds a shield to the housing “so as to provide a secure electrical contact between said shield and said housing.” The Office Action has asserted that the cable

bushing provides an electrical contact between a shield and a housing. That is not the case. To have an electrical contact makes no sense since the signals are contained within signal lines. Furthermore, if electrical signals were conveyed by the cover of cable 66, there would be possible problems with shorting when contact was made with the cover 64. Accordingly, there is no suggestion in Ernst to have the bushing provide an electrical contact between a shield and a housing, the rejection is improper and should be withdrawn.

The rejection of claim 6 is improper for the additional reason that there is no suggestion in Ernst to use an adhesive provided in the opening between the cable cord 66 and the cover 64. The Office Action appears to be saying that it would have been obvious to replace the bushing with an adhesive. Such a replacement misses the point. The invention of claim 6 requires that the deformation and the adhesive are present. Since Ernst does not suggest using both an integral deformation and an adhesive, the rejection is improper and should be withdrawn.

The rejection of claim 7 is improper for the additional reason that there is no suggestion in Ernst to use an intermediate ply provided in the opening between the cable cord 66 and the housing. The Office Action appears to be saying that it would have been obvious to replace the bushing with an intermediate ply. However, the invention of claim 7 requires that the deformation and the intermediate ply are present. Since Ernst does not suggest using both an integral deformation and an intermediate ply, the rejection is improper and should be withdrawn.

It is noted that the Office Action has failed to provide any motivation based on Ernst or the prior art to use the adhesive or intermediate ply recited in claims 6 and 7. Instead, the Office Action imposes an obvious to experiment standard. Such a standard is improper. *In re Dow Chem. Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). The Office Action imposes yet

another improper standard in that it relies on Applicant's own intended use for his own invention to provide motivation to reject the claims. This is a clear instance of improper hindsight being used to reject the invention. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Instead, the test is whether the reference in question, in this case Ernst, taken as a whole would suggest the invention to one of ordinary skill in the art. *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 220 USPQ 97 (Fed. Cir. 1983).

It is noted that the Office Action has cited the *In re Leshin* case for the proposition that the material of claims 6 and 7 would have been obvious based on Applicant's intended use for the material. That reliance is in error for the reasons given in Applicant's Amendment filed on February 23, 2006, the entire contents of which are incorporated herein by reference.

## **2. Ernst and Schneider et al.**

Claims 2-5 and 8 were rejected under 35 U.S.C. § 103 as being obvious in view of Ernst and Schneider et al. Claim 2 depends directly on claim 1. As mentioned above in Section A.1, Ernst fails to suggest having its cover include an integral deformation and to use a shielded cable having a shield which prevents electro-magnetic interference and forms an electrical contact with a housing. Schneider et al. fails to cure the deficiencies of Ernst in that it fails to suggest altering Ernst's wall to include an integral deformation and to use a shielded cable having a shield which prevents electro-magnetic interference and forms an electrical contact with a housing. Without such suggestion, the rejection is improper and should be withdrawn.

It is noted that the Office Action has asserted that Schneider et al.'s cable has a shield as recited in claim 1. While Schneider et al. does disclose a shield 144, Schneider et al. uses a

connector 170 to attach electric cable 140 to chassis 130. There is no discussion in Schneider et al. to use an integral deformation as recited in claim 1. Accordingly, the rejection is improper and should be withdrawn.

Applicant traverses the rejections of claims 3-5 in that an item 10 has been identified as a deformation and the rejections refer to first and second portions without identifying what elements in Ernst or Schneider et al. are regarded as the deformation and first and second portions. This is unfair to the Applicant and Applicant demands that the next Office Action explicitly what elements in the references are being relied on to reject the claim.

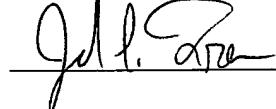
Applicant traverses the rejection of claim 8 in that neither Ernst nor Schneider et al. disclose or suggest using the recited elastic intermediate ply that is “provided in said opening between said shielded cable and said housing.” The Office Action has failed to recite any portion of Ernst or Schneider et al. that discloses or suggests using the recited elastic intermediate ply. The Office Action attempts to overcome this deficiency by relying on *In re Leshin*. This reliance is misplaced for reasons similar to those given in Applicant’s Amendment filed on February 23, 2006.

### **CONCLUSION**

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-11 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes

that an interview would be helpful to resolve any remaining issues, she is respectfully requested to contact the undersigned attorney at (312) 321-4200.

Respectfully submitted,



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